

The opinion in support of the decision being entered today was **not** written
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UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**



Ex parte MANABU HARAGUCHI

Appeal No. 2006-1281
Application No. 09/926,029

HEARD: JUNE 6, 2006

Before FRANKFORT, CRAWFORD, and BAHR, Administrative Patent Judges.

BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claims 8 and 9.

We AFFIRM.

BACKGROUND

The appellant's invention relates to a packaging paper roll for use in a solid preparation packaging apparatus. According to appellant (specification, page 1) the terminology "solid preparation" refers to "all solidified preparations such as a tablet, capsule, pill, and troche." Independent claim 8 is representative of the appellant's invention and reads as follows:

8. A paper roll for packaging a solid preparation, comprising:

an elongated hollow wall defining a tubular shaft member having concentrically spaced inside and outside surfaces, said outside surface being adapted for receiving a thermally fusible packaging paper wound therearound, said packaging paper being in a double folded state with a folded portion thereof being disposed on an end of the shaft member; and

at least two notches having a limited length from an end of said shaft member, each said notch being defined by a recess disposed in the inner surface of said wall of said shaft member communicating with the end of said shaft member and extending to a radial depth short of the outside surface thereof, each said recess forming a thinner, more flexible portion of the wall than portions of the wall between at least two of said recesses.

Applied Prior Art

Watanabe	4,684,272	Aug. 4, 1987
Haraguchi et al. (Haraguchi)	5,819,500	Oct. 13, 1998
Kanai	5,931,588	Aug. 3, 1999

The Rejections

Claims 8 and 9 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the appellant's specification so as to convey to one of ordinary skill in the art that the appellant, at the time the application was filed, had possession of the claimed invention.

Claims 8 and 9 also stand rejected as being unpatentable over Watanabe or Kanai in view of Haraguchi or, in the alternative, as being unpatentable over Haraguchi in view of Watanabe or Kanai.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding this appeal, we make reference to the examiner's answer (mailed November 1, 2005) for the examiner's complete reasoning in support of the rejections and to the appellant's brief (filed August 26, 2005) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the following determinations.

We turn first to the rejection of claims 8 and 9 under the first paragraph of 35 U.S.C. § 112 as lacking written description support. In making this rejection, the examiner contends that the recitation “each said recess forming a thinner, more flexible portion of the wall than portions of the wall between at least two of said recesses” in claim 8 lacks written description support in the application as originally filed. The examiner’s findings that appellant’s specification “is silent regarding the flexibility of the wall portions located immediately radially outwardly of the recesses” (answer, page 4) and that “[t]here is no disclosure [in appellant’s specification] that [the wall of the tubular shaft member 21] is made of a single homogeneous material” (answer, page 6) are correct.

The test for determining compliance with the written description requirement, however, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555,

1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). In this case, appellant's specification indicates, on page 12, that the packaging paper roll 19 is constituted of a hollow tubular shaft member 21 "of a boxboard (a hard synthetic resin may be used)" and does not indicate that the shaft member material lacks homogeneity in any portion thereof. In the absence of any such disclosure in appellant's specification or drawings, one of ordinary skill in the art would have immediately envisaged a homogeneous shaft member material and, hence, increased flexibility, at least to some degree, in the notched or engaged portions 21A as compared to the portions between such engaged portions. We find nothing in the appellant's description (specification, pages 22-23) of the Figure 8 embodiment, wherein the outer portion of the lower edge of the shaft is uncut, as preventing or inhibiting collapse of the lower edge of the shaft member by pressure during winding of the packaging paper 20 that indicates or implies that the uncut portions should be made of a less flexible material, as contended by the examiner on page 6 of the answer.

In light of the above, despite the lack of literal support in appellant's application as originally filed for the "each said recess forming a thinner, more flexible portion of the wall" limitation, we conclude that appellant's specification would have conveyed such to one of ordinary skill in the art. Accordingly, the examiner's rejection under 35 U.S.C. § 112, first paragraph, is not sustained.

We turn our attention now to the rejection of claims 8 and 9 as being unpatentable over Watanabe or Kanai in view of Haraguchi or Haraguchi in view of Watanabe or Kanai. The appellant's only argument as to why the subject matter of claims 8 and 9 is not unpatentable over these references is that none of the cited references "teaches, mentions or suggests" the feature "each said recess forming a thinner, more flexible portion of the wall than portions of the wall between at least two of said recesses" (brief, page 10). The same reasoning that supports appellant's position with regard to the written description rejection, discussed above, supports the examiner's position with respect to the obviousness rejection, as explained below.

Watanabe discloses a tubular ribbon-winding core 5 provided with grooves 5a extending inwardly from one end thereof into which key-like projections 16 on the core-engaging portion 6 of the spool shaft 2 are inserted. The grooves 5a are formed only part-way into the wall of the ribbon-winding core 5.

Kanai discloses a winding core in a ribbon cassette, the winding core 1 being formed generally in a cylindrical shape and having an inner peripheral surface 2 formed with a plurality of engaging grooves 7 for engagement with a plurality of engaging projections 37 formed on the outer peripheral surface of a winding bobbin 35A. The engaging grooves are formed such that three engaging grooves have insertion sides on one axial end side of the winding core and three engaging grooves have insertion sides

on the opposite end side. As best seen in Figure 5, the grooves 7 extend only part-way into the wall of the winding core.

Much like the appellant's specification, there is no indication in either Watanabe or Kanai that the core 5 of Watanabe or 1 of Kanai is made from a non-homogeneous material. Accordingly, the examiner's determination that it would have been obvious to form the cores from a single substantially uniform (i.e., homogeneous) material for reasons of efficiency since there is nothing in the references to suggest the need to do otherwise (answer, page 6) is well-reasoned. Just as in the case of appellant's disclosure, we find that one of ordinary skill in the art would have immediately envisioned that the thinner regions of the grooves 5a of Watanabe or 7 of Kanai would have increased flexibility relative to the portions of the wall between the grooves. The appellant's argument thus is unpersuasive of any error on the part of the examiner in rejecting claims 8 and 9 under 35 U.S.C. § 103 as being unpatentable over the applied references. The rejection is sustained.

CONCLUSION

To summarize, the rejection of claims 8 and 9 under the first paragraph of 35 U.S.C. § 112 is reversed and the rejection of claims 8 and 9 under 35 U.S.C. § 103 is sustained. A rejection of each of the claims on appeal having been sustained, the decision of the examiner is **AFFIRMED**.

AFFIRMED

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